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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/510,715  | 10/18/2004  | Alfred Ruland        | 259939US0PCT        | 9295             |
| 22850   | 7590        | 12/19/2007           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | MRUK, BRIAN P       |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 1796                 |                     |                  |
|   |             | NOTIFICATION DATE    | DELIVERY MODE       |                  |
|   |             | 12/19/2007           | ELECTRONIC          |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
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|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/510,715             | RULAND ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Brian P. Mruk          | 1796                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 December 2007.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11,14-22 and 24-30 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 15-21 is/are allowed.
- 6) Claim(s) 11,14,22 and 24-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 4, 2007 has been entered.
2. This Office action is in response to Applicant's amendment filed December 4, 2007. Applicant has amended claims 11, 15 and 18. Claims 12 and 23 have been cancelled. Currently, claims 11, 14-22 and 24-30 remain pending in the application.
3. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office actions, Paper Nos. 20070216 and 20070826.
4. The rejection of claims 11, 14, 22 and 24-30 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoffarth, U.S. Patent No. 5,705,476, is maintained for the reasons of record.

5. The rejection of claims 12, 15-17, 20, 21, and 23 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoffarth, U.S. Patent No. 5,705,476, is withdrawn in view of applicant's amendments and remarks.

6. The rejection of claims 18-19 under 35 U.S.C. 103(a) as being unpatentable over Hoffarth, U.S. Patent No. 5,705,476, in view of Clement et al, WO 01/04183, is withdrawn in view of applicant's amendments and remarks.

7. The provisional rejection of claims 11, 12 and 14-30 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/575,760 is withdrawn in view of applicant's amendments and remarks.

#### ***Response to Arguments***

8. Applicant's arguments filed December 4, 2007 have been fully considered but they are not persuasive.

Applicant argues that Hoffarth, U.S. Patent No. 5,705,476, does not teach or suggest in general a composition comprising an alkoxylate compound for use in the specific methods required in newly amended claim 11. In response to applicant's argument that that Hoffarth does not teach or suggest in general a composition comprising an alkoxylate compound for use in the specific methods required in newly

amended claim 11, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the examiner asserts that the compositions disclosed in Hoffarth would be capable of performing the intended uses, since the compositions disclosed in Hoffarth are used in methods of cleaning and treating substrates that are analogous to those required in the instant claims.

Applicant further argues that Hoffarth, U.S. Patent No. 5,705,476, does not teach or suggest in general the specific alkoxylate of formula I, wherein a short chain propylene or butylene oxide moiety is directly connected to the alkyl radical, and a relatively long ethylene oxide moiety is connected to the propylene or butylene oxide moiety. However, the examiner respectfully disagrees. Specifically, Hoffarth clearly discloses an alkoxylate compound of formula Ic, wherein 1 mole of propylene oxide (i.e. p is 1) is connected directly to the alkyl radical, and 10 moles of ethylene oxide (i.e. q is 10) is connected to the propylene oxide moiety (see abstract and see col. 1, line 45-col. 2, line 20), as required in the instant claims. It is noted by the examiner that instant claim 11, as presently written, requires the variable A to be either propyleneoxy or buteneoxy, which is clearly taught by Hoffarth. The examiner asserts that the 1 mole of propylene oxide and 10 moles of ethylene oxide for the compound in Ic are disclosed with sufficient specificity in the Hoffarth reference. Furthermore, the examiner asserts

that Hoffarth clearly discloses that the alkyl radical (i.e. R<sup>1</sup>) includes iso-decyl (see col. 2, lines 23-45 and col. 3, lines 1-11), as required in the instant claims.

***Allowable Subject Matter***

9. Claims 15-21 are allowable over the prior art of record, since the prior art of record does not teach or suggest in general a composition containing the specific alkoxylate compound required in instant claims 15-21.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPM

Brian P Mruk  
December 11, 2007

Brian P. Mruk

Brian P Mruk  
Primary Examiner  
Art Unit 1796